

## Remarks

### I. Status of the Application and Claims

As originally filed, the present application had a total of 77 claims. Claims 59-77 were cancelled in a Preliminary Amendment filed by Applicants. Claims 30-50 and 55-58 were cancelled in response to a restriction requirement and claims 16, 52 and 53 were withdrawn from consideration as being directed to a non-elected species. Thus, the claims now pending are 1-15, 17-29, 51 and 54.

### II. Confirmation of Claim Cancellation

Applicants hereby confirm that claims 30-50 and 55-58 have been cancelled.

### III. Comments Regarding Priority

On pages 2 and 3 of the Office Action, the Examiner indicates that Applicants have not been granted priority with respect to Application 08/718,585 because the applications do not name at least one common inventor. As discussed below, Applicants believe that the Examiner is mistaken in denying priority.

By way of background, it should be noted that the present application is a divisional of 09/159,158 which named five inventors: William Brown; John DiMaio; Peter Schiller; Rene Martel; and Wuyi Wang. The '158 application was a continuation-in-part formed by combining United States applications 08/718,585 and 08/392,918. These previous applications did not share a common inventor but were commonly owned and were combined for the purpose of avoiding a rejection under § 102(e). Prosecution on the '585 application was separately continued and this eventually issued as U.S. 6,337,319, *i.e.*, the reference the Examiner has relied upon in rejecting claims in the present Office Action. The present application also claims priority to several other applications, including PCT/SE95/00158. A copy of this PCT application is included herewith and is used in Applicants arguments with respect to the rejection of claims under § 102(b) based upon the reference of Saenger.

Applicants have carefully examined the law with regard to priority and believe that

the Examiner is mistaken in concluding that priority to the '585 application has been lost in the present divisional application. When the present application was initially filed, it was a duplicate of the parent application and included all of its claims along with a declaration executed by all of the inventors of the parent, including Dr. Wang (the sole inventor named on application 08/718,585). Inventorship changed in the divisional application because Applicants filed a Preliminary Amendment in which claims that Wang alone contributed to were deleted. This was done in accordance with 37 C.F.R. § 1.48(d).

Applicants submit that there is no basis in the law for concluding that priority in an application is lost in its divisional under these circumstances. In this regard, the Examiner's attention is drawn to the Example in MPEP § 201.03 (see pages 200-8 to 200-9). In this example, an application is filed naming inventors A and B. Due to a cancellation of claims, inventor B is eliminated before this application issues as a patent. A divisional application is then filed in which A is deleted. Despite the lack of overlapping inventors, the example makes it clear that priority is maintained. In fact, the example expressly states:

The inventorship overlap required by 35 U.S.C. § 120 is met in this instance even though at the time of filing of the divisional application, the inventorship overlap was lost as a result of the deletion of inventors in the parent application. The overlap of inventorship need not be present on the date the continuing application is filed nor present when the parent application issues or becomes abandoned.

Based upon the above quotation, Applicants submit that priority is not lost in a divisional application as the result of deleting an inventor due to the cancellation of claims. Applicants believe that merely filing a divisional which includes all of the matter of the parent and the originally filed declaration is sufficient.

*Alternative Proposal*

If the Examiner would prefer, Applicants would consider reentering a claim from the

parent application that Dr. Wang contributed to and reinstating him as an inventor in the divisional. For the reasons discussed above, Applicants believe that this is not necessary but, they know of nothing in the rules that would prevent them from doing so.

### **The Rejections**

The present Office Action rejects all pending claims under 35 U.S.C. § 102. The rejection is based upon two different references. Wang, *et al.* (now U.S. 6,337,319) and Saenger (Abstract No. 127:311488).

Applicants respectfully traverse this rejection.

The Wang patent (U.S. 6,337,319) corresponds to the application discussed above in connection with priority (*i.e.*, application 08/718,585). Since Applicants believe that they are fully entitled to maintain priority, it is respectfully submitted that the Examiner's rejection of claims based upon the cited reference is not justified.

Claims 1-15, 17-29 and 51 and 54 are also rejected under 35 U.S.C. has being anticipated by Saenger, *et al.* (Database Caplus AN 127-311488). However, the Saenger reference indicates that it was not published until 1997. In contrast, Applicants have relied upon priority to PCT Application PCT/SE95/00158. This was filed on February 15, 1995 and published in English on August 24, 1995. All of the inventors named on the '158 application are included in the present application and its disclosure fully supports the present claims (see copy of PCT application enclosed). Since the application was filed well before the publication of the cited reference, it is respectfully submitted that the reference does not constitute prior art.

### Conclusion

In light of the discussion above, Applicants submit that all of the Examiner's rejections have been overcome. It is therefore respectfully requested that these rejections be withdrawn and that the present case be allowed to issue.

If, in the opinion of the Examiner, a phone call may help to expedite the prosecution of this application, the Examiner is invited to call Applicants undersigned attorney at (202) 419-7013.

Respectfully submitted,

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